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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,186	02/26/2002	Mario Galasso	SOM-GAL-PI	8209
7590	06/03/2004		EXAMINER	BOEHLER, ANNE MARIE M
Evelyn M. Sommer Attorney at Law 30th Fl. 825 Third Avenue New York, NY 10022			ART UNIT	PAPER NUMBER
			3611	
			DATE MAILED: 06/03/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/086,186	GALASSO, MARIO
	Examiner	Art Unit
	Anne Marie M Boehler	3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 March 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-5,7-11 and 14-20 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 2-5,7-11,14 and 18-20 is/are allowed.
- 6) Claim(s) 15-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, "such as" is an indefinite term.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore.

Moore shows a telescoping bicycle suspension including a steering tube 2, a crown 10, stanchion tubes 3, and slider tubes 5. The stanchion tubes slide within the slider tubes and both sets of tubes have a generally elliptical cross-sectional shape (see Figure 3) which does not permit relative rotational movement.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Lin.

Moore shows the aspect ratio of the elliptical cross section that appears to be approximately .5, rather than .7 and it is silent regarding the actual dimensions of the tubing.

Lin teaches using tubular frame members in a bicycle frame whereby the tubular members have an elliptical shape with an aspect ratio of approximately .7. It also indicates that the maximum dimension of the rear fork members may range from 40mm to 75mm (1.5 to 3 inches, which would make the smaller dimension between 1 and 2 inches).

It would have been obvious to one of ordinary skill in the art to dimension the Moore to have an aspect ratio of about .7 and have cross sectional dimensions of, for example 1 inch and 1.5 inches, as taught by Lin, in order to optimize the cross sectional shape. Moore is also silent regarding the length of the stanchions, however, it would have been an obvious design choice to make the stanchions approximately 8-12 inches long with three inches of travel, in order to accommodate the dimensions of standard mountain bikes.

6. Claims 2-5, 7-11, 14, and 18-21 are allowed.
7. Applicant's arguments filed December 1, 2003 and March 4, 2004 have been fully considered but they are not persuasive.

Applicant argues that Moore fails to teach stanchion tubes with elliptical or non-circular cross section. The examiner disagrees. Although the text of Moore is silent regarding the cross sectional shape of the stanchions, the figures clearly show telescoping stanchions 3 and slider tubes 6 having an oblong, generally elliptical cross

section (shown in Figure 3). It is clear that this non-circular cross section does not allow relative rotational movement between the tubes. Therefore, the claims language is met by Moore.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie M Boehler whose telephone number is 703-308-0422. The examiner can normally be reached on 7:30-5:00, Monday-Thursday, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

amBohler 6/1/04

Anne Marie M Boehler
Primary Examiner
Art Unit 3611

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